

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH HARRIS
and JACQUELINE B. WAHL

Appeal No. 2003-1930
Application No. 09/797,326

ON BRIEF

Before OWENS, DELMENDO and JEFFREY T. SMITH, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellants have filed a paper under 37 CFR § 1.197(b) requesting that we reconsider our decision of September 26, 2003, wherein we affirmed the rejection of claims 1 to 20 under 35 U.S.C. § 103(a).¹

¹ The request for rehearing was filed November 26, 2003.

Appeal No. 2003-1930
Application No. 09/797,326

37 CFR § 1.197(b) (1997) provides as follows:

Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See § 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

We have reconsidered our decision of September 26, 2003 in light of Appellants' comments in the request for rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision for the reasons which follow.

Appellants assert that "[t]he Board did not understand that Appellants have provided evidence demonstrating an unexpected result." (Rehearing request, p. 1). We disagree. As indicated at page 8 of our decision, "Appellants can over come a *prima facie* case of obviousness by establishing the claimed range achieves unexpected results relative to the prior art range." *See In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). ("The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. *See, e.g., Gardner v. TEC Sys., Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir.), cert. denied, 469 U.S. 830 [225 USPQ 232] (1984); *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA

1980); *In re Ornitz*, 351 F.2d 1013, 147 USPQ 283 (CCPA 1965); *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955). These cases have consistently held that in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range.”)

In the present case the Appellants have relied on a single example, that falls within the disclosure of the claimed invention, to establish the allegedly unexpected results. Appellants assert the comparison to the alloy CM 186 LC[®] is within the preferred ranges of Yoshinari. (Rehearing request, p. 2). However we note that the CMSX[®]-486 alloy falls within the broad disclosure of Yoshinari.² According to Appellants, Rehearing request page 2, the alloys CM 186 LC[®] and CMSX[®]-486 are compositionally similar except for the amount of chromium and tantalum. Appellants have not explained why alloy CMSX[®]-486 is representative of the claimed invention and not of the Yoshinari reference. Appellants have also not adequately explained why alloy CMSX[®]-486 is commensurate in scope with the range of alloys encompassed by the claimed subject matter. *See In re Boesch*, 617 F.2d at 276, 205 USPQ at 219. The establishing of the significance of the claimed range is especially relevant in this appeal where Yoshinari discloses alloy components in ranges

²“[I]n a section 103 inquiry, ‘the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.’” *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) (quoting *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976)).

encompassing the claimed alloy component ranges. The alloy CMSX[®]-486 is limited to only one composition however, the claims are not so limited.

Appellants also have not shown why the alloy CM 186 LC[®], alleged to be representative of the Yoshinari reference, is believed to be the closest prior art. *See In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 71 (CCPA 1979). We note that Appellants, Rehearing request page 2, have indicated that the comparative alloy CM 186 LC[®] has been optimized for high temperature strength. However, Appellants have not indicated that this is the same procedure required by Yoshinari. Nonetheless, the results sought to be proven by the various alloys discussed in the specification are lost since the alloy CMSX[®]-486 falls within the scope of the disclosure of Yoshinari.

Appellants assert the affirmation of the rejection based on Harris is improper because the rejection is based exclusively on Harris. Specifically, Appellants are questioning our determination that “a person of ordinary skill in the art would have reasonably recognized the results that would have been obtained by adjusting the content of Ta and Cr.” (Rehearing request, p. 4). We are not persuaded by Appellants’ argument. In an obviousness determination it is not improper to refer to extrinsic evidence, such as references or declarations. Extrinsic evidence may be considered when it is used to explain, but not expand, the meaning of a reference. *Scripps Clinic & Research Foundation v. Genentech*,

Appeal No. 2003-1930
Application No. 09/797,326

Inc., 927 F.2d 1565, 1576-77, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Here, the reference to the Yoshinari reference was to establish that persons of ordinary skill in the art would have recognized the result that would have been obtained by adjusting the amount of chromium and tantalum in a nickel based alloy.

Appellants provide additional argument directed to the significance of the data in the specification. (Rehearing request pp. 4-5). These additional arguments are not persuasive for the reasons stated above and in our prior decision.

We have granted Appellants' request to the extent that we have reconsidered our decision of September 26, 2003, but we deny the request with respect to making any changes therein.

Appeal No. 2003-1930
Application No. 09/797,326

Time for taking action

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING DENIED

TERRY J. OWENS
Administrative Patent Judge

ROMULO H. DELMENDO
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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Appeal No. 2003-1930
Application No. 09/797,326

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